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JUN 24 2009

OFFICE OF PETITIONS

In re Application of
Drummond et al.
Application No. 09/077,337
International Filing Date: November 25, 1997
For: AUTOMATED BANKING MACHINE
APPARATUS AND SYSTEM

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: Petition for
: Patent Term Extension
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The above-identified application has been forwarded to the undersigned for consideration on a petition entitled "Petition(s) under 37 CFR 1.181 and/or 37 CFR 1.182," received on March 31, 2009. The petition is being treated as a petition under 37 CFR 1.181 and 37 CFR 1.701, and as a petition under 37 CFR 1.182.

The petition under 37 CFR 1.181 is dismissed.

The petition under 37 CFR 1.182 is dismissed.

Background

Petitioner notes that the above-identified application was filed on May 27, 1998¹, and allowed on February 17, 2009, but issuance was delayed due to two suspensions in prosecution and for an appeal to the Board of Appeals and Patent Interferences. Petitioner asserts that the USPTO failed to provide patent term extension for the two suspensions in prosecution initiated by the Examiner and alternatively for the amount of patent adjustment since the application is eligible for patent term adjustment provisions. Petitioner asserts that since these time periods were not included in the patent term extension calculation, that the 1584 days of patent term extension in the Notice of Allowance and Issue Fee Due mailed on February 24, 2009 is incorrect.

Petitioner asserts that the application was suspended for two periods, the first period beginning on October 1, 2002 and ending on April 9, 2003, and the second period beginning on February 8, 2006 and ending August 18, 2006. Petitioner argues that the patent is eligible for 192 days of patent term extension for the first interference but that this does not include the time for the second suspension.

¹ Actual filing date is the international filing date, which is November 25, 2007.

Petitioner asserts that the second suspension was interference related and thus Applicants are entitled to additional patent term extension. Petitioner asserts that the second suspension was an unlawful taking of time as the suspension was not signed by a TC Director as required by the MPEP. Petitioner further asserts that the Office never responded to the request for reconsideration. Petitioner asserts that this unlawful taking is a violation of the Administrative Procedures Act. Petitioner asserts that the patent term extension does not include additional time for this second suspension, which comprises **192 days** of patent term extension.

Petitioner asserts that the indicated patent term does not include the patent term adjustment time. Petitioner asserts that the patent is entitled to patent term adjustment based on the Patent term Guarantee Act of 1999. Petitioner asserts that since the application was pending on May 29, 2000, the date when the legislation went into effect, that the patent is entitled to patent term adjustment under the patent term adjustment provisions. Petitioner asserts that since the application was pending, it has "the status of having been 'filed on' the effective date of Pub. L. 106-113."

Petitioner asserts that patent is entitled to at least an additional 192 days of patent term extension. Petitioner asserts that the period of extension under 37 CFR 1.701 should be at least 1776 days (1584 + 192) due to delays by the Office.

On November 25, 1997, the above identified application was filed.

On July 30, 2001, a Notice of Appeal was received by the Office.

On October 1, 2002, a first Letter of Suspension was mailed by the Office.

On April 1, 2003, a "Notice of Expired Suspension" was submitted by Applicant.

On November 29, 2005, a decision by the Board of Patent Appeals and Interferences reversing the Examiner was mailed by the Office.

On February 8, 2006, a second Letter of Suspension was mailed by the Office.

On February 24, 2009, a Notice of Allowance and Fee Due notice was mailed by the Office.

Decision

The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154. 35 U.S.C. § 154 provides for patent term extension for appellate review, interference and secrecy order delays in utility and plant applications filed on or after June 8, 1995, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for other specifically defined administrative delays in utility and plant applications filed on or after May 29, 2000.

The above-identified application was filed on November 25, 1997. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute.

A Notice of Appeal was filed in the above-identified application on July 30, 2001. On November 29, 2005, the Board of Appeals and Interferences reversed the decision of the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in a reversal of an adverse decision of patentability, the patent to issue from the application is entitled to an extension of the patent term. The period of delay in the above-identified application is the period beginning on July 30, 2001, the date that the Notice of Appeal was filed, and ending on November 29, 2005, the date of the final decision in favor of the applicant. Three years after the international filing date of the application is November 25, 2000. Accordingly, the period of extension is not required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the filing date of the application. As a result, the period of extension is **1584 days**, which is the period from July 30, 2000 to November 29, 2005, including the beginning and end dates.

In order to implement 35 U.S.C. 154(b) (in effect between June 8, 1995 and May 28, 2000), the Office promulgated 37 CFR 1.701(c)(1)(ii), which, consistent with the statute, requires an interference proceeding under 35 U.S.C. 135(a) to be eligible for patent term extension due to a suspension of action.

Petitioner asserts that under 37 CFR 1.701(c)(1); the patent term extension should be at least 192 days but then argues that the patent term extension should be 192 days for each of the two delays due to the two suspensions in prosecution initiated by the Examiner. According to the Letter of Suspension mailed on October 1, 2002, the suspension was to await the outcome of a pending Interference. While the letter of suspension did not state the length of the suspension, Office procedures limit a suspension of action to 6 months. See MPEP 709. Petitioner submitted a letter to the Office on April 1, 2003, notifying the Office of the end of the 6 month period. As a result, the period of extension for the first suspension is 182 days, which is the period from October 1, 2002 to April 1, 2003, including the beginning and end dates, however this period is overlapping with the period for the appeal. In accordance with 37 CFR 1.701(c)(1), an application is not entitled to periods that are overlapping, thus the application is entitled to no patent term extension due to the first suspension.

Petitioners argument that the second suspension is Interference related because it is associated with the first suspension and that it was an unlawful taking is not persuasive with respect to patent term extension under 35 U.S.C. 154. According to the Letter of Suspension mailed on February 8, 2006, examination of the application was suspended to await a reference that may soon become available. Although prosecution was suspended, the second suspension was not for the reason that the subject application was involved in an interference, or to await the result of an interference proceeding in another application.

As a result, the provisions of 37 CFR 1.701(c)(1)(ii) do not apply to the second suspension because this section applies to suspensions by the “Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application,” and in this instance there were no such other interference proceedings. Therefore, Petitioner’s argument that he is entitled to patent term extension for the periods of the two suspensions under 37 CFR 1.701(c)(1)(ii) is not persuasive.

Petitioner’s argument that the application is eligible for patent term adjustment because it was still pending when the legislation became effective is not persuasive. The effective date provision (§ 4405) in the legislation (American Inventor Protect Act of 1999, date of enactment November 29, 1999) clearly states that the amendments to 35 U.S.C. § 154 apply to applications filed on or after the date that is 6 months after the date of enactment, i.e., May 29, 2000. This provision does not include applications that were filed prior to the date of enactment or even immediately after the date of enactment, but applications that were filed on or after the date that is 6 months after the date of enactment. Petitioner’s assertion that since the application was pending it has “the status of having been ‘filed on’ the effective date of Pub.L. 106-113” is without merit. The Office has no authority to make the provisions applicable in the instant application. See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*, 65 FR 56366 (Sept. 18, 2000) 1239 Off. Gaz. Pat. Office Notices 14 (Oct. 3, 2000).

The delay in issuance of petitioner’s patent is regretted. However, the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. § 41(a)(7). Accordingly, as authorized the \$400 fee for the petition under 37 CFR 1.182 has been charged to Petitioner’s Deposit Account (09-0428).

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy



Ralph E. Jocke
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&
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March 23, 2009

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Mail Stop ISSUE FEE
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re: Application No.: 09/077,337
Confirmation No.: 5900
Applicants: Jay Paul Drummond, et al.
Filed: May 27, 1998
Title: Automated Banking Machine
Apparatus and System
Art Unit: 3691
Notice of Allowance Date: February 24, 2009
Docket No.: D-1077

Sir:

Please find enclosed the Issue Fee Transmittal form for filing. Also enclosed are Petition(s) under 37 CFR 1.181 and/or 37 CFR 1.182 regarding patent term extension and "Comments on the Statement of Reasons for Allowance".

If necessary, please charge a 37 CFR 1.17(h) petition fee (\$130) and any other fee due to Deposit Account 09-0428.

Very truly yours,



Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Mail Stop ISSUE FEE, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 31 day of March 2009.

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